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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,713	10/06/2003	Kamran Mohsenin	86816F-P	2887

7590 04/29/2008  
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EXAMINER
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MCINTYRE, CHARLES AARON

ART UNIT	PAPER NUMBER
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4176

MAIL DATE	DELIVERY MODE
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04/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/679,713	<b>Applicant(s)</b> MOHSENIN ET AL.	
	<b>Examiner</b> C. Aaron McIntyre	<b>Art Unit</b> 4176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1, 3, 20, 22, 36-38 objected to because of the following informalities:
  - a. Claims 1 and 20: Examiner is interpreting "said first device" to be --said first sending device-- for the purposes of clarity.
  - b. Claim 3 and 22: The claim does not end in a period.
  - c. Claims 36-38: There is a space missing in "claim 20wherein" which should be --claim 20 wherein--.Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
3. Claims 20-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As interpreted by Examiner, claim 20 recites "a computer software program for use on a computer" as well as similar wording in claims 21-38, which Examiner views as software per se which does not fall within one of the enumerated statutory categories.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-17 and 20-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. (6,636,259). Anderson et al. was previously published as WO 0209435 on January 31, 2002 which could be used as a 35 U.S.C. 102(b) rejection. However, the references cited below cite U.S. Patent No. 6,636,259 (issued Oct. 21, 2003).

6. Referring to claims 1 and 20, Anderson et al. disclose a method for storing and retrieving digital media (col. 2, ll. 36-58), comprising the steps of: receiving a digital media from a sending device of a user by a service provider that was sent over a communication network (col. 4, ll. 24-31), said service provider having a database

having a plurality of customer accounts for storing of digital media with respect to said associated customer accounts (col. 4, ll. 9-31); examining a message associated with said digital media that has been forwarded from said first device so as to obtain a sender ID (col. 7, ll. 62-67, col. 8, ll. 1-4); searching said database to determine if said ID is associated with one of said customer accounts (col. 8, ll. 1-4); forwarding said digital media to said database if said associated customer account exists and associating said digital images with said associated customer account (col. 8, ll. 1-4); and establishing a temporary account if no associated customer account exists and storing said digital media in said database and associating said stored digital media with said temporary account (col. 10, ll. 29-47); and associating a PIN with respect to said temporary account and forwarding said PIN to the user for use in accessing said stored digital media (col. 10, ll. 37-47, *password*).

7. Referring to claims 2 and 21, Anderson et al. disclose wherein the PIN is sent to the user via the sending device (col. 10, ll. 37-47, *password*).

8. Referring to claims 3 and 22, Anderson et al. disclose wherein said sending device comprises a wireless device (col. 4, ll. 39-46, col. 10, ll. 37-47).

9. Referring to claims 4 and 23, Anderson et al. disclose wherein said wireless device is digital media capture device (col. 4, ll. 39-52, *digital camera*, col. 10, ll. 37-47).

10. Referring to claims 5 and 24, Anderson et al. disclose wherein said wireless device comprises a phone camera (col. 4, ll. 39-54, *the camera could be provided with built-in cellphone-like wireless communication*, col. 10, ll. 37-47).

11. Referring to claims 6 and 25, Anderson et al. disclose wherein said sending device comprise a personal computer (col. 1, ll. 50-66, col. 9, ll. 21-24, *creation without the use of a PC*).

12. Referring to claims 7 and 26, Anderson et al. disclose wherein said ID comprises at least one of the following: phone number of said sending device; e-mail address of the sending device; phone number of the user; e-mail address of the user; unique ID of the sending device; unique ID of the user (col. 10, ll. 29-37).

13. Referring to claims 8 and 27, Anderson et al. disclose wherein a text message including said PIN number is sent to the sending device (col. 10, ll. 38-47, *information packet ... account password*).

14. Referring to claims 9 and 28, Anderson et al. disclose wherein a text message including said PIN number is sent to the user (col. 10, ll. 38-47, *information packet ... account password*).

15. Referring to claims 10 and 29, Anderson et al. disclose wherein said user uses said PIN number for accessing said digital media stored in said temporary account (col. 2, ll. 36-54, *user account information is then stored on electronic device for use the next time the electronic device accesses the website*, col. 3, ll. 12-24, *automatically establishing accounts*, col. 11, ll. 57-67, *temporary account*).

16. Referring to claims 11 and 30, Anderson et al. disclose wherein said user establishes a permanent customer account (col. 11, ll. 57-67, *[p]lease complete the account setup within 30 days*).

17. Referring to claims 12 and 31, Anderson et al. disclose wherein said forwarding of said digital media is accomplished by use of e-mail (col. 2 ll. 3-12, *allows the user to e-mail the images directly from the camera*).

18. Referring to claims 13 and 32, Anderson et al. disclose wherein said forwarding of said digital media is accomplished by use of multimedia message service (MMS) (col. 2 ll. 3-12, *allows the user to e-mail the images directly from the camera. The user simply connects his or her digital camera to a cellphone or modem*).

19. Referring to claims 14 and 33, Anderson et al. disclose wherein said digital media is sent to an e-mail address of said service provider (col. 2, ll. 13-26, *Although emailing photos directly from the camera allows users who do not own a PC to share images over the Internet, these users must still establish accounts with both an Internet service provider (ISP) and the photo-sharing website before being able to post their images*).

20. Referring to claims 15 and 34, Anderson et al. disclose wherein said digital media is sent over at least two different times (col. 8, ll. 21-24, *sending the images to a list of email addresses*, col. 12, ll. 43-61, *pictures are sent as before*).

21. Referring to claims 16 and 35, Anderson et al. disclose wherein said message being examined includes a message header (col. 2, ll. 3-13, *e-mail*).

22. Referring to claims 17 and 36, Anderson et al. disclose wherein said digital media comprises a digital image (col. 1, ll. 41-58).

***Claim Rejections - 35 USC § 103***

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 18-19 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (6,636,259) in view of Jackson et al. (2002/0105658). Jackson et al. has a common assignee and was filed Dec. 6, 2000.

25. Anderson et al. disclose a method for storing and retrieving digital media, as applied in the above rejection of claims 1 and 19 under U.S.C. 102(e), but Anderson does not expressly disclose that said digital media could comprise a video clip or simply text.

26. However, Jackson et al. disclose a similar system and method which indeed does expressly disclose wherein said digital media comprises a video clip or text.

27. Referring to claim 18, Jackson et al. disclose wherein said digital media comprises a video clip (§ 78).

28. Referring to claim 19, Jackson et al. disclose wherein said digital media comprises text (§ 78).

29. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Anderson et al. so as to include



sending a video clip or text in accordance with the teachings of commonly assigned Jackson et al., in order to expand the options available to the user since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

### ***Conclusion***

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- d. U.S. Patent No. 5,974,401 (issued Oct. 26, 1999) to Enomoto et al.
- e. U.S. Publication No. 2002/0087546 (published Jul. 4, 2002) to Slater et al.
- f. U.S. Publication No. 2003/0182143 (published Sep. 25, 2003) to Conrad et al.
- g. U.S. Publication No. 2003/0236832 (published Dec. 25, 2003) to McIntyre et al.
- h. U.S. Patent No. 7,336,775 (issued Feb. 26, 2008) to Tanaka et al.
- i. U.S. Patent No. 7,363,235 (issued Apr. 22, 2008) to Urabe et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Aaron McIntyre whose telephone number is (571) 270-5401. The examiner can normally be reached on Monday to Thursday 9-6 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. A. M./  
Examiner, Art Unit 4176

/Gerald J. O'Connor/  
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